

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Palani Balaya

Application No.: 10/527,638

Confirmation No.: 9536

Filed: August 19, 2005

Art Unit: 1795

For: NOVEL ELECTRODES FOR LI-BASED
ELECTROCHEMICAL ENERGY STORAGE
DEVICES AND LI-BASED
ELECTROCHEMICAL STORAGE DEVICE

Examiner: Ben Lewis

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the election requirement issued in Paper No. 20090913 mailed September 16, 2009, the Applicant elects to prosecute the invention of Group II directed to a Li-based electrochemical energy storage device of transition metal clusters, M, LiF-M with LiF dispersed on an atomic or nanometer scale.

Applicant makes the election of Group II **with traverse** and respectfully requests reconsideration of the requirement for restriction or, in the alternative, modification of the restriction requirement to allow simultaneous prosecution of Groups II and III designated by the Examiner in the present application for the reasons provided as follows. First, claims 1-4 and 9-11 (Group I), 5 and 6 (Group II) and claims 7 and 8 (Group III) all recite compositions for which no different classification is noted. Further, independent claim 7 of Group III is so

intimately related to subject matter of elected claim 5 of Group II so as to create no additional burden of examination. Claim 8 is tailored to $\text{Li}_2\text{O}-\text{M}$ composite where M is Ru or Mo initially, and the storage device elements recited are aspecific and as such pose no additional search burden. Similarly, the independent claims of Group I in reciting a lithium-based device with transition metal halide and a recited polymeric binder relative to Group II that does not create an undue burden during the examination process.

Under 35 U.S.C. §121 “two or more independent and distinct inventions . . . in one Application may . . . be restricted to one of the inventions.” Inventions are “independent” if “there is no disclosed relationship between the two or more subjects disclosed” (MPEP 802.01). The term “distinct” means that “two or more subjects as disclosed are related . . . but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER” (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification;
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, “[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (MPEP 803) (emphasis added).

Applicant respectfully submits that Groups I-III designated by the Examiner fail to define compositions with properties so distinct as to warrant separate classification, status in the art or a

different field of search. The search for any of the forms of the inventive composition separately classified by the Examiner as the inventions of Groups I-III would require an additional search of the identical classes wherein the materials per se are classified, thus resulting in a duplicate search. Absent a showing of separate classification in the art, Applicant submits that the search and examination of Groups I-III can be made without serious burden, and therefore the Examiner must examine these claims of the application on the merits.

The Examiner's assertion to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all of the claims of the present application would not present an undue burden on the Examiner, and accordingly, modification to include claims drawn to claims 1-4 and 7-11 of Groups I and III is believed to be in order. Alternatively, modification of the restriction requirement to include Group III is requested.

Summary

Applicant elects with traverse Group II and respectfully requests that the restriction requirement be modified to include the remaining groups, or at least Group III.

Dated: October 16, 2009

Respectfully submitted,
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